

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN E. MOLTER

Appeal No. 97-2822
Application 08/455,900¹

ON BRIEF

Before MEISTER, FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed May 31, 1995. According to appellant, the application is a continuation of Application 08/333,598, filed November 2, 1994, abandoned; which is a continuation of Application 08/106,238, filed August 13, 1993, abandoned.

Appeal No. 97-2822
Application 08/455,900

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5, 6 and 9 through 16. Claims 3, 4, 7, 8 and 17, the only other claims pending in the application, stand withdrawn from further consideration based on an election of species requirement also made in the final rejection (Paper No. 23).

Appellant's invention relates to a floor drain extension (e.g., claims 1, 10 and 11), a floor drain extension combination (claim 13), and to a method of repositioning a drain plate normally located atop a conventional fixed in place non-adjustable floor drain by using the above-noted floor drain extension (e.g., claims 5 and 9). Claims 1, 5, 9, 10, 11 and 13 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief and the Appendix to the examiner's answer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mayer	1,959,171	May 15, 1934
-------	-----------	--------------

Appeal No. 97-2822
Application 08/455,900

Seewack	2,859,452	Nov. 11, 1958
Morris et al. (Morris)	3,362,425	Jan. 9, 1968
Emberson	4,943,100	July 24, 1990

Claims 5 and 9 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as his invention. In the examiner's view (answer, page 4), the claims are unclear as to the scope thereof. In this regard, it is the examiner's position that

[t]he preambles call for a "method" but the bodies appear to rely upon structural features of a product for patentability. Stated differently, claims 5 and 9 recite a method which as understood should define a process including novel and unobvious steps. To the contrary, appellant argues at pages 11-12 of the brief that his method claims are patentable because of the specific product being manipulated by the otherwise unpatentable process steps. In any event, the preamble of claim 6 clearly reflects the intended scope of claim 5.

In addition to the foregoing rejection, the appealed claims stand rejected under 35 U.S.C. § 102 and § 103 as follows:

a) claims 10, 11 and 16 under § 102(b) as being anticipated by Emberson;

b) claims 10, 11, 13, 14 and 16 under § 103 as being unpatentable over Emberson;

Appeal No. 97-2822
Application 08/455,900

c) claims 12 and 15 as being unpatentable over Emberson as applied to claims 10 and 11 above, and further in view of Seewack; and

d) claims 1, 2, 5, 6 and 9 as being unpatentable over Morris in view of Mayer.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 28, mailed March 4, 1997) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 27, filed January 21, 1997) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Appeal No. 97-2822
Application 08/455,900

We turn first to the examiner's rejection of appealed claims 5 and 9 under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification and claims 5 and 9 in light thereof, and also in light of appellant's arguments on pages 11 and 12 of the brief, it is our opinion that the scope and content of the subject matter embraced by appellant's claims 5 and 9 on appeal is reasonably clear and definite, and fulfills the requirement of 35 U.S.C. § 112, second paragraph, and that they provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). There is no confusion in our minds concerning the scope of appellant's claims 5 and 9 on appeal. These claims are clearly directed to a method of repositioning a drain plate atop a conventional form of floor drain by using a specific type of annular body set forth therein. In contrast to the examiner's opinion, it is our view that, if anything, it is the preamble of dependent claim 6 which should be brought into conformity with

the preamble of its parent method claim 5. We note particularly, that the terminology "floor drain extension" as used in the preamble of dependent claim 6 is not used anywhere in parent claim 5 and thus finds no clear antecedent basis therein. Given the foregoing, we will not sustain the examiner's rejection of appellant's claims 5 and 9 under 35 U.S.C. § 112, second paragraph.²

We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims 10, 11 and 16 under 35 U.S.C. § 102(b) as being anticipated by Emberson. Independent claim 10 defines a floor drain extension comprising an annular ring having upper and lower planar surfaces, a round outer surface bounded by the upper and lower planar surfaces, and an inner, generally circular surface. In addition, the floor drain extension of appellant's claim 10 is said to include "a pair of oppositely located bores extending through said annular ring from said upper planar surface and extending completely through said lower planar surface." The

² However, for the reasons which we have indicated above, we suggest that the examiner consider such a rejection of dependent claim 6 or, alternatively, merely have appellant provide an appropriate correction of the preamble of this dependent claim.

bores referred to in appellant's claim 10 are clearly the bolt holes (20) seen in Figures 3 and 4 of the application drawings. According to the examiner (answer, pages 4-5), the floor drain of Emberson includes an annular ring (18) having a lower surface (adjacent 28), an upper surface (22), an outer surface, an inner surface, and a pair oppositely located chamfered bores (receiving 24). The examiner urges (answer, page 5) that the "bores [of Emberson] extend 'from said upper planar surface' (claim 10) in the same sense as do appellant's bores" (emphasis in original).

After a careful assessment of appellant's claim 10 and the Emberson reference, we must disagree with the examiner's determination that the annular ring (18) is fully responsive to (i.e., anticipatory of) the floor drain extension defined in appellant's claim 10 on appeal. Having identified the upper surface (22) of the annular ring (18) in Emberson as the "upper planar surface" set forth in appellant's claim 10, we do not see how the examiner can say that the bores located in the radially disposed leg (20) of the ring in Emberson, which receive the screws (24), extend "from said upper planar surface" through the annular ring and extend completely through said lower planar

Appeal No. 97-2822
Application 08/455,900

surface, as required in claim 10 on appeal. As is readily apparent from viewing Figures 1, 2 and 3 of Emberson, the bores referred to by the examiner for receiving the screws (24) in Emberson are far removed the "upper planar surface" (22) of the ring (18). For this reason alone, the examiner's rejection of independent claim 10 and dependent claim 16 under 35 U.S.C. § 102(b) based on Emberson will not be sustained.

Independent claim 11 on appeal is directed to a floor drain extension like that seen in Figure 2 of the drawing correction filed by appellant on November 27, 1996 (as an attachment to Paper No. 24), which drawing correction was approved for entry by the examiner on December 9, 1996 (Paper No. 25). Claim 11 sets forth that the annular ring of the drain extension includes a "continuous groove extending completely around the annular extent of said extension," and "a pair of oppositely located bores extending through said annular ring from said upwardly disposed surface of said groove." Like the examiner, we are of the opinion that the annular ring (18) of Emberson is fully responsive to the drain extension of appellant's claim 11 on appeal. In contrast to appellant's arguments, we consider that the groove for receiving the drain

cover plate or grate (32) of Emberson is "a continuous groove extending completely around the annular extent of said extension." Nothing in appellant's claim 11 requires that the groove be smooth and/or be without other structure on the upwardly disposed surface thereof, as appellant seems to urge on page 18 of the brief. As for the requirement for "a pair of oppositely located bores extending through said annular ring from said upwardly disposed surface of said groove," we view the bores in the ring (18) of Emberson which receive the

screws (24) to be broadly "oppositely located," in the sense that at least two of these bores are disposed on opposite sides of a central vertical plane passing through the center point of the annular ring (18). With this understanding of Emberson and the breadth of appellant's claim 11 on appeal, we will sustain the examiner's rejection of independent claim 11 under 35 U.S.C. § 102(b).

We next consider the examiner's rejection of claims 10, 11, 13, 14 and 16 under § 103 as being unpatentable over Emberson. In this instance, the examiner has taken the position that to the extent the bores of Emberson may not be "oppositely

located/disposed," it would have been obvious to one of ordinary skill in the art to provide such an arrangement so as to allow the ring (18) therein to be associated with different types of conventional floor drains. For the same reasons as noted above, we will not sustain the examiner's § 103 rejection of independent claim 10 or independent claim 13, or of claims 14 and 16 which depend, respectively, from claim 13 and claim 10. In Emberson, the bores clearly do not extend through the ring "from said upper planar surface" and extend completely through said lower planar surface, as required in appellant's claims 10 and 13. Regarding

claim 11, we will sustain the examiner's rejection, primarily because appellant has not argued that the examiner's stated modification of Emberson would have been unobvious. Moreover, we must agree with the examiner that one of ordinary skill in this art would have understood that the three bore arrangement of Emberson is but one of the known arrangements of such bores in the prior art, and that such an artisan would have found it obvious to alternatively use an arrangement having two oppositely located bores, for example, as is seen in appellant's own "conventional" drain structure depicted in Figure 1 of the application drawings.

As for the rejection of claims 12 and 15 under 35 U.S.C. § 103 based on Emberson and Seewack, we will sustain the examiner's rejection of dependent claim 12, but not the rejection of dependent claim 15. Claim 15 depends from independent claim 10 and thereby includes all of the limitations of that independent claim. Thus, since the teachings of Seewack do not supply that which we have found lacking in Emberson above with regard to independent claim 10, it follows that the rejection of dependent claim 15 under 35 U.S.C. § 103 cannot be sustained. As for dependent claim 12, we note that this claim adds to the floor drain extension defined in independent claim 11 on appeal that the groove therein is "a right angled groove." Seewack shows such a groove in the ring (27) therein for supporting the drain cover plate or strainer (32). As we noted above in our treatment of claim 11, Emberson also shows a groove for receiving the drain cover plate or grate (32) therein, however, that groove has an angled upwardly disposed wall. Like the examiner, we are of the view that it would have been obvious to one of ordinary skill in the art to provide the annular ring member (18) of Emberson with a right angled groove as seen generally in Seewack. Appellant's arguments on pages 24-25 of the brief do nothing to change our

opinion, since in contrast to appellant's first argument the ring (18) of Emberson clearly provides an "extension" of the drain body (10) therein, while the arguments numbered 2) and 3) on page 25 of the brief are directed to limitations not found in claims 11 and 12 on appeal.

The last of the examiner's rejections for our review is that of claims 1, 2, 5, 6 and 9 as being unpatentable over Morris in view of Mayer. Like appellant, we are of the opinion that Morris and Mayer are not properly combinable in the manner urged by the examiner. Moreover, even if one were to make the multiple shim rings (56) of Morris' Figure 6 into a single shim or annular ring member, the resulting structure and method would not be that which is claimed by appellant. The shim rings (56) of Morris have no upright smooth-wall bolt holes therethrough alignable with the plurality of drain cover plate mounting holes as required in independent claims 1, 5 and 9 on appeal, nor any need for such bolt holes. In addition, and as a result of not having the above-noted bolt holes, we observe that the annular body of Morris as modified by the examiner would not be capable of functioning in the manner required in the last clause of

Appeal No. 97-2822
Application 08/455,900

appellant's independent article claim 1 and method claims 5 and 9. For these reasons, the examiner's rejection of claims 1, 2, 5, 6 and 9 under 35 U.S.C. § 103 will not be sustained.

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection against claims 11 and 12 on appeal.

Claims 11 and 12 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which, as originally filed, does not provide "written description" support for the invention as now claimed. Claims 11 and 12 are directed to the embodiment of the floor drain extension seen in the drawing correction filed by appellant on November 27, 1996 (as an attachment to Paper No. 24), which drawing correction was approved for entry by the examiner on December 9, 1996. However, in our opinion, the annular ring (10) seen in Figure 2 of the drawing correction as having a groove in the upper surface thereof for receiving the drain cover plate (C) is new matter, because no such extension ring was previously shown or disclosed in the application as originally filed. Figure 2 as originally

filed shows the drain cover plate (32) positioned directly on the upper surface of the extension ring (10) and the specification expressly describes this particular arrangement. See, for example, page 4, lines 22-25, and page 5, lines 4-6, of the specification. Thus, we must conclude that the extension ring now seen in Figure 2 of the drawing correction lacks "written description" in the application as originally filed.

To summarize our decision, we note that 1) the examiner's rejection of claims 5 and 9 under 35 U.S.C. § 112, second paragraph, has not been sustained, 2) the examiner's rejection of claims 10, 11 and 16 under 35 U.S.C. § 102(b) has been sustained with regard to claim 11, but not with regard to claims 10 and 16, 3) the rejection of appealed claims 10, 11, 13, 14 and 16 under 35 U.S.C. § 103 relying on Emberson alone has been sustained with regard to claim 11, but not with regard to claims 10, 13, 14 and 16, 4) the rejection of claims 12 and 15 under 35 U.S.C. § 103 relying on Emberson and Seewack has been sustained with regard to claim 12, but not with regard to claim 15, and 5) the rejection of claims 1, 2, 5, 6 and 9 under 35 U.S.C. § 103 based on Morris

Appeal No. 97-2822
Application 08/455,900

and Mayer has also not been sustained. In addition, based on the authority provided by 37 CFR § 1.196(b), we have entered a new ground of rejection against claims 11 and 12 on appeal under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is, accordingly, affirmed-in part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

Appeal No. 97-2822
Application 08/455,900

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application,

Appeal No. 97-2822
Application 08/455,900

abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Appeal No. 97-2822
Application 08/455,900

Curtis L. Harrington
6300 State University Drive
Suite 250
Long Beach, CA 90815